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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,228	03/29/2001	Takashi Tsue	2091-0236P-SP	2183

2292 7590 06/22/2004

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EXAMINER

BASHORE, WILLIAM L

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,228

Applicant(s)

TSUE, TAKASHI

Examiner

William L. Bashore

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: original application filed 3/29/2001. The instant application claims a foreign priority date of **3/29/2000**.
2. Claims 1-18 are pending. Claims 1, 6, 11, 13, 15, 17 are independent claims.

Claim Rejections - 35 USC § 101

3. **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **The claimed invention (as claimed in claims 1-14) is directed to non-statutory subject matter.**

In regard to independent claims 1, 6, 11, 13, the combined limitations in each of said claims (reading a user image, inserting the user image, a template, etc.), can be interpreted as a series of mental and/or manual steps for creating a catalog, therefore, the claimed invention is directed to non-statutory subject matter.

The examiner's suggestion of changing the preamble in each of said claims to read "*A computer executable template...*" will serve to overcome this rejection.

In regard to dependent claims 2-5, 7-10, 12, 14, claims 2-5, 7-10, 12, 14 are rejected for fully incorporating the deficiencies of their respective base claims.

Examiner's Note

The following rejections are based upon a possible interpretation of the instant claims as directed towards computer executable templates.

Claim Rejections - 35 USC § 103

5. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayle et al. (hereinafter Mayle), U.S. Patent No. 6,542,936 issued April 2003, in view of Manolis et al. (hereinafter Manolis), U.S. Patent No. 6,583,799 issued June 2003.**

In regard to independent claim 1, Mayle teaches a method of creating an image display (i.e. a customized electronic postcard) (Mayle Abstract, column 2 lines 35-51). Mayle's customization process is a series of input screens associated with clickable tabs, said screens can be interpreted as a series (plurality) of templates, because each screen is specifically tailored to input and produce a piece of a final structured result (intermediate results are also displayed as a postcard is built) (Mayle column 8 lines 21-42, 60-67, Figures 6-17). In addition, a user can choose an image (i.e. a user image – "andrew2.gif") for insertion, accordingly (Mayle Figure 9-10). It is noted that no particular tab order is specified, therefore when a photo is inserted (Figure 11 – after insertion, or at beginning), said photo is essentially inserted in all of the templates (including the final result) (compare with claim 1 "*A template displaying method comprising the steps of: reading a user image and a plurality of templates each having an image insertion area for inserting the user image therein; inserting the user image in the image insertion area of each of the templates...*").

Mayle teaches embodiments comprising the display of a "Baby Journal" and a "Family Album", which are forms of catalogs, typically comprising user images (Mayle column 13 lines 50 to column 14 lines 12). Mayle does not specifically teach displaying the templates within said catalog. However, Manolis teaches uploading image data forming a catalog of images displayed to a user (Manolis Abstract, Figures 8-9; compare

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with claim 1 “...and generating a catalog of the templates”, and “displaying the catalog.”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Maolis’s display of user images to Mayle, so that each of Mayle’s templates (with user image) can be displayed concurrently to a user for more concise inspection and customization, resulting in a more complete baby journal/family album.

In regard to dependent claims 2, 3, 4, Mayle does not specifically teach lower resolution images and templates. However, Manolis teaches thumbnail generation (lower resolution) in association with a catalog display (Manolis column 7 lines 4-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Manolis’s low resolution method to Mayle’s images and template images, providing Mayle the benefit of thumbnail representations for a more complete catalog picture.

In regard to dependent claim 5, Mayle teaches various images available for choosing (as explained above) (see Mayle Figure 10).

In regard to independent claim 6, claim 6 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claims 7, 8, 9, 10, claims 7, 8, 9, 10 incorporate substantially similar subject matter as claimed in claims 2, 3, 4, 5, and are rejected along the same rationale.

In regard to independent claim 11, claim 11 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 12, Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to independent claim 13, claim 13 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claim 14, Mayle teaches a plurality of user images available for use (Mayle Figure 10). Mayle also teaches using a new template (Mayle Figure 17 items 1703a, 1703b).

In regard to independent claim 15, claim 15 reflects the computer readable medium comprising computer readable instructions used for performing the method as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claim 16, Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to independent claim 17, claim 17 reflects the apparatus comprising computer readable instructions used for performing the method as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mayle teaches a plurality of user images available for use (Mayle Figure 10).

In regard to dependent claim 18, Mayle teaches a plurality of user images available for use (Mayle Figure 10). Mayle also teaches using a new template (Mayle Figure 17 items 1703a, 1703b).

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Conclusion

7. **Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.**

Morag U.S. Patent No. 6,324,545 issued 11-2001

Loui, Alexander et al., A software system for automatic albing of consumer pictures, ACM International Multimedia Conference, October 1999, pp. 159-162.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is **(703) 308-5807**. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild, can be reached on **(703) 305-9792**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 305-3900**.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703-872-9306) (for formal/after-final communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



William L. Bashore
Patent Examiner, AU 2176
June 19, 2004